

REMARKS

This paper is presented in response to the Office Action. By this paper, claims 1, 11, and 15 are amended, claim 31 is canceled and claim 35 is added. Claims 19-22 were previously canceled and claims 12-14 and 23-28 were previously withdrawn. Claims 1-11, 15-18, 29, 30, and 32-35 are now pending in the application.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

a. claim amendments and cancellations

With particular reference to the claim amendments, Applicants note that while claims 1, 11, and 15 have been amended herein and claim 31 has been canceled herein, such amendments and cancellations have been made in the interest of expediting the allowance of this case. Notwithstanding, Applicants may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicants hereby reserve the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicants submit that neither the claim cancellations and new claims set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicants in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

b. remarks

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of

the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note as well that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teachings and purported prior art status of the cited references at any appropriate time.

c. present understanding of the references

In connection with the prosecution of this case, as well as any related cases, the Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Inasmuch as such discussion could, at times, reflect an incomplete or incorrect understanding of one or more of the references however, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable, and Applicants hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to such reference.

II. Claim Rejections under 35 U.S.C. § 101

The Examiner has rejected claims 1-10 and 29-34 under 35 U.S.C. § 101 for purportedly not being drawn to patent-eligible subject matter. The Examiner has further asserted that "while the claimed process contains physical steps (generating, making, updating), it does not involve transforming an article into a different state or thing." *Office Action*, page 2. Inasmuch as claim 31 has been canceled herein, Applicants submit that the rejection of claim 31 has been rendered moot and should be withdrawn. With respect to the other rejected claims, Applicants respectfully disagree, and submit that at least for the following reasons the rejections should be withdrawn.

As noted recently by the U.S. Court of Appeals for the Federal Circuit in *In Re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), the "raw materials of many information-age processes ... are electronic signals and electronically-manipulated data." *Id.* at 962. With reference to a previous court decision that upheld the patent-eligibility of a claim that transformed data representing "physical and tangible objects" into a different state, the Federal Circuit affirmed the patent-eligibility of the claim and further noted that "the electronic transformation of the data itself ... was sufficient, the claim was not required to involve any transformation of the underlying physical object that the data represented." *Id.* at 962-63 (*citing In Re Abele*, 684 F.2d 902 (C.C.P.A. 1982)).

Independent claim 1 recites acts that transform data representing "physical and tangible objects" into a different state. In particular, claim 1 recites acts that transform electronic "human resources compliance forms" into a different state by first "generating" and then "updating" one or more of the "human resources compliance forms." As noted in paragraph [043] of the specification:

The term "form" and "human resources form" should be broadly construed to include any employee form, template, manual or other material that can be used to implement a human resources process. Non-limiting examples of forms include applications, authorizations, requests, disclosures, instruction materials, and training materials.

Applicants note that a "human resources compliance form" can be either electronic or physical. One example of a physical "human resources compliance form," namely a paper employment application, is disclosed in paragraphs [050] and [066]. An example of the conversion of a physical "human resources compliance form" to an electronic "human resources compliance form," through scanning a paper form, is disclosed in paragraph [050]. Therefore, although the "human resources compliance forms" recited in claim 1 are electronic "human resources compliance forms," Applicants submit that these electronic "human resources compliance forms" recited in claim 1 represent underlying "physical and tangible objects," namely, physical "human resources compliance forms."

Further, claim 1 is directed to a method that transforms one or more "human resources compliance forms" into a different state. In particular, each of the rejected claims initially "generat[es] a plurality of human resources compliance forms" that substantially conform to predetermined legal criteria" and then "update[es], as required, at least one of the plurality of

human resources compliance forms to conform with a change in the legal criteria." (*Emphasis added*). Therefore, in claim 1, the "human resources compliance forms" are initially generated in a first state, and then transformed into a second state by being "updat[ed]... to conform with a change in the legal criteria."

Therefore, at least because claim 1 transforms data representing "physical and tangible objects" into a different state, Applicants respectfully submit that claim 1, and corresponding dependent claims 2-10, 29, 30, and 32-34, are patent-eligible under 35 U.S.C. § 101. Accordingly, the rejections of claims 1-10, 29, 30, and 32-34 under 35 U.S.C. § 101 should be withdrawn.

III. Claim Rejections under 35 U.S.C. § 103(a)

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. See *MPEP* § 2141.III. As stated by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____, 82 USPQ2d 1385 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that "...[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1396.

The Examiner has rejected claims 1-11 and 29-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. US 7,330,817 B1 to Exall et al. ("*Exall*") in view of Peace Corps Applicant Toolkit ("*PC*"). The Examiner has also rejected claims 15-18 under 35 U.S.C. § 103(a) as being unpatentable by *Exall* in view of *PC* in further view of U.S. Patent Number 6,067,522 to Warady et al. ("*Warady*"). The Examiner has also rejected claim 34 under 35 U.S.C. § 103(a) as being unpatentable by *Exall* in view of *PC* in further view of U.S. Patent Publication No. 2002/0055862 to Jinks ("*Jinks*"). Inasmuch as claim 31 has been canceled herein, Applicants submit that the rejection of claim 31 has been rendered moot and should be withdrawn. With respect to the other rejected claims, Applicants respectfully disagree, and submit that at least for the following reasons the rejections should be withdrawn.

Applicants have amended claim 1 herein to recite, among other things:

“...determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client...”

As well, Applicants have amended claim 11 to recite in part:

“...determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client; and making the updated human resources compliance form available to the client in an order that has been dynamically updated to accommodate the change in the legal criteria.”

Finally, Applicants have amended claim 15 herein to recite, among other things:

“...wherein at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria, and wherein an order in which the updated forms are made available to the client has been dynamically updated to accommodate the changes in the legal criteria...”

Support for these amendments can be found at least in paragraphs [048], [051]-[053], [060], and [073] and Figure 2.

In the rejection of claim 1, the Examiner has conceded that "Exall does not explicitly disclose activities performed in a specific order based on status and legal requirements." However, the Examiner has alleged that "PC teaches activities performed in a specific order based on status and legal requirements. (Pages 4-9, steps 3 and 5-9 show steps being done in a specific order in which each step must be completed before the next one is started based on status and legal requirements)."

Despite this assertion, however, the Examiner has not demonstrated the PC teaches "determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client" (emphasis added) as recited by amended claim 1, or that PC teaches *“...determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client; and making the updated human resources compliance form available to the client in an order that has been dynamically updated to accommodate the change in the legal criteria”* (emphasis added) as recited in claim 11, nor has the Examiner demonstrated that PC teaches *“...wherein at least one of the forms is*

dynamically updated by the server to reflect changes in the legal criteria, and wherein an order in which the updated forms are made available to the client has been dynamically updated to accommodate the changes in the legal criteria..." as recited by amended claim 15. (*Emphasis added*).

Instead, the order in which the screens of pages 4-9 of *PC* are presented to a user appear to be fixed, and no evidence of this order being "dynamically updated" to accommodate a change or changes in any "legal criteria" is apparent from the face of these pages. For example, nine (9) steps are listed in a certain order on page 3 of *PC*, and six (6) of these nine (9) steps are shown in the same order on the screens of pages 4-9. However, *PC* makes no mention of this order being "dynamically updated" to accommodate a change or changes in "legal criteria" as recited by each of the pending independent claims 1, 11, and 15. One of many potential benefit of this recited element of amended claims 1, 11, and 15 is noted in paragraph [053] of the specification:

[053] According to another embodiment, the order in which forms are presented to the client will also change dynamically to accommodate changes in the legal criteria and/or status data received from the client. For example, if a change in a law included a provision requiring all employees to review new training materials, the server would automatically generate the appropriate training materials with a corresponding data structure for tracking the employees training progress.

In view of the foregoing, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness with regard to claims 1, 11, and 15, at least because the Examiner has not shown that the references, when combined in the allegedly obvious fashion, include all the elements of claims 1, 11, and 15. Applicants thus submit that the rejection of claims 1, 11, and 15, as well as the rejection of corresponding dependent claims 2-10, 16-18, 29, 30, and 32-34, should be withdrawn.

IV. Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise

been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants believe that claims 1-11, 15-18, 29, 30, and 32-35 are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 19th day of March 2009.

Respectfully submitted,

/Peter F. Malen, Jr. /Reg. # 45576

Peter F. Malen Jr.
Attorney for Applicants
Registration No. 45,576
Customer No. 022913
Telephone: (801) 533-9800